

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Michael Reed et al.

Application No.: 08/113,955

Confirmation No.: 3543

Filed: August 31, 1993

Art Unit:

For: MULTIMEDIA SEARCH SYSTEM

Examiner:

REQUEST FOR RECONSIDERATION OF DISMISSAL OF PETITION UNDER
37 C.F.R. §1.53(b) and/or 37 C.F.R. §1.182 FOR GRANT
OF A FILING DATE AND AMENDMENT OF APPLICATION

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is a Request for Reconsideration of the Dismissal of August 6, 2008 of the Petition under 37 C.F.R. §1.53(b) for grant of a filing date of August 31, 1993 to the above-identified application and a Petition under 37 C.F.R. §1.182 to amend the above-identified application to claim priority under 35 U.S.C. §120 to parent application 07/426,917, now U.S. Patent 5,241,671. While Petitioner believes that the requested relief may be granted under the specified rules, should there be a need to waive any other provisions of the regulations in the interest of justice, waiver is hereby requested and the Commissioner is authorized to charge any required fees for the relief sought to Petitioner's deposit account 50-2929. The Background outlined below includes some of the details of the events as outlined in the original Petition filed on November 1, 2007. However, in the interest of brevity, this Request for Reconsideration will not repeat all the details outlined in the original Petition. The Deciding Official is invited to review the original Petition for a more detailed outline of the Background to the events leading to the filing of the Petition.

BACKGROUND1. Parent Application/Patent

Applicant's attorney, of the Dickstein Shapiro LLP Firm ("Dickstein Firm") filed Application Serial No. 07/426,917 ('917) on October 26, 1989. The '917 Patent Application eventually issued on August 31, 1993 as U.S. Patent 5,241,671 ('671 patent). *See Grossman Decl. ¶ 3.*

2. Sandwich Applications

A continuation patent application was filed under 37 CFR §1.60 on the date of issuance of the '671 patent application. That continuation application, which was eventually assigned Serial No. 08/113,893 ('893) was filed with the requisite filing fee, a declaration and a preliminary amendment with a claim for priority under 35 USC §120. *See Grossman Decl. ¶ 5.*

Applicant's attorney did not receive confirmation of filing the '893 patent application from the courier, as was the customary practice at the Dickstein Firm. In an abundance of caution, Applicant's attorney caused a second patent application to be filed, using a copy of the first filed continuation application. The second application was filed under 37 CFR §1.53. However, this back-up application was filed without a fee, a copy of the Declaration and a Preliminary Amendment claiming priority benefit under 35 U.S.C. §120 to the parent application. The second application was eventually assigned Serial No. 08/113,955 ('955). *See Grossman Decl. ¶ 6.*

At the time of filing, Applicant's attorney believed both applications were complete copies of the '917 application. *See Grossman Decl. ¶ 8.* In any event, the absence of page 1 was a minor

oversight as that page did not include critical information to the application. Rather, the descriptive portion on page 1 was limited to a discussion of the background of the invention, clearly a non-essential component of the Specification. The reference to the parent application which usually appears on page 1 of the Specification can simply appear in the Declaration under 37 C.F.R. §1.63 or could be added at a later date by way of a preliminary amendment.

On September 14, 1993, the PTO mailed to the Dickstein Firm a Notice of Incomplete Application in the '955 application indicating that page 1 was missing. Applicant was given the option of submitting the missing page and obtaining as a filing date for the application, the date of receipt of that missing page or keeping the application without page 1 and retaining the original filing date. Applicant opted for the latter option due to the non-criticality of page 1 as explained above. *See Grossman Decl. ¶ 9.*

On October 1, 1993, the PTO mailed to the Dickstein Firm a Notice of Incomplete Application due to a missing page 1 for the '893 application with exactly the same options provided in the '955 application. *See Grossman Decl. ¶ 10.*

On October 29, 1993 the Dickstein Firm filed in the '955 application a preliminary amendment deleting the incomplete text on page 2, and filed a Petition for the original filing date. On the same date, an express abandonment was filed in the '893 application. Since the administrative staff at the Dickstein Firm placed both of the application copies, i.e., the '893 and the '955 application copies in the same file-wrapper, Applicant's attorney simply filed a petition in one application and an express abandonment in the other application. Thus, when a petition in the '955 application and an express abandonment in the '893 application were being reviewed for filing, Applicant's attorney did not appreciate the difference in their contents. With the benefit of

hindsight, differences did exist between the two applications. However, the most important aspect of Applicant's attorney's actions is that there was never an intent to abandon both applications or in any way to not obtain a filing date for one application. *See Grossman Decl.* ¶¶ 11-12.

On February 16, 1994, the PTO dismissed the Petition in the '955 application for lack of a proper Declaration and provided a two month period for reconsideration under 37 C.F.R. §1.181(f).

Applicant's attorney had some difficulty in obtaining all the inventors' signatures on the Declaration under 37 C.F.R. 1.63, and he decided to file a continuation application. On February 28, 1994, he filed a Request for a four month extension of time in the '955 application. *See Grossman Decl.* ¶¶ 14-15.

3. Child Application/Patent

Applicant's attorney filed on that same date of February 28, 1994, Application No. 08/202,985, which was filed as a continuation application under 37 C.F.R. §1.53 (hereafter "child application"), claiming benefit under 35 U.S.C. §120 to the '955 sandwich application. The '985 patent application was also filed without page 1. By way of an Amendment filed on September 11, 1995, Applicant amended the Specification by inserting on page 2 thereof the following:

"This is a continuation of application Ser. No. 08/113,955, filed 8/31/93, now abandoned, which is a continuation of application Ser. No. 07/426,917, filed 10/26/89, Pat. No. 5,241,671".

A Petition regarding missing page 1 and Petition to accept the Declaration with less than all the inventors' signatures was filed on August 29, 1994 in the '985 application and was granted on

September 15, 1995. Thus, the child application was considered complete by the PTO at least as of September 15, 1995. Since the PTO granted priority requested under 35 USC §120 to the '917 application, Applicant's attorney believed that the '985 application properly claimed priority benefits under 35 USC §120 to the parent ('955) and grandparent ('917) applications. *See Grossman Decl. ¶ 18.*

The child application matured into U.S. Patent No. 6,546,399 on April 8, 2003 as a "continuation of Application No. 08/113,955" (2nd sandwich application), "which is a continuation of Application No. 07/426,917" (parent application). Applicant's attorney was unaware of any filing date or priority claim problems with the child patent until approximately October 5, 2007, when the issue was raised by an accused infringer in litigation proceedings related to this family of patents. *See Grossman Decl. ¶ 19 and Exhibit 1 attached thereto.*

RESPONSE TO ISSUES RAISED IN DISMISSAL OF AUGUST 6, 2008

In a Decision dated August 6, 2008, the PTO dismissed the Petition filed on November 1, 2007 based on a number of issues raised by the Deciding Official. Each of the issues will be summarized below in the order in which they were raised by the Deciding Official and Petitioner's response will be provided immediately after each issue identified in the Decision.

A. The Decision makes reference to the language of 37 C.F.R. §1.181(f), specifically as to that rule's permission to dismiss a petition not filed within two months of the mailing date of the action or notice from which relief is requested. The Decision deems that action or notice to be the petition decision mailed by the PTO on February 16, 2004, which was more than 13 years and 8 months ago. Accordingly, the Decision of August 6, 2008 dismisses the Petition filed on November 1, 2007 as untimely. *See 1st full paragraph on page 6 of the Decision.*

As the Deciding Official is well aware, the language of 37 C.F.R. §1.181(f) is intentionally permissive in nature to permit consideration of petitions filed long after a decision or notice is rendered, where as here, fair application of the rules requires consideration of the petition on the merits. The PTO has a long history of considering favorably petitions filed many years after a decision or notice is rendered, where on a case-by-case basis, such consideration is justified. The Decision of February 16, 1994 was believed to no longer require a response by virtue of the fact that a request for a four month extension of time was filed on February 28, 1994, along with a continuation application. Thus, from Applicant's attorney's perspective, prosecution was to continue in the child application without a need to continue prosecution of either of the two sandwich applications. The decision of February 16, 1994 no longer required a response. The true "decision or notice" that first made Applicant aware of a possible problem in the copendency chain of the child application all the way back to its grandparent application took place on or about October 5, 2007 as is evident in paragraph 19 of the Grossman Declaration. The PTO accepted the child application as a proper continuation application and rendered a decision on a petition dealing with this very question, positively confirming the grant of the original filing date and the priority benefits that accrued from that filing date. Eventually, the PTO issued that application as a patent. The PTO's actions in the child application were either intended to constitute a waiver of the requirement that similar documents be filed in the parent application (i.e., the sandwich application), or else these actions lulled Applicant into a false sense of security. To dismiss the Petition on the basis that it was untimely, would be inconsistent with PTO's handling of similar petitions it has handled. In fact, the Official Gazette at 1059 OG 4 specifically recognizes the need to grant relief where the PTO lulls an applicant into a false sense of security by its acceptance of a continuation application where a lack of copendency with the parent application is not discovered until much later.

B. The Decision cites Korsinsky v. Godici, 2005 U.S. Dist. LEXIS 20850 (S.D.N.Y. 2005), to justify its holding that the Petition is untimely. *See 1st full paragraph on page 6 of the Decision.*

It is respectfully submitted that the present case bears no similarity to the Korsinsky v. Godici case. In Korsinsky v. Godici, the patent owner was given the option of requesting reconsideration of a dismissal of his petition, or requesting a refund of maintenance fees paid. The patent owner gave up the petition process and chose to request a refund of maintenance fees until much later when he became aware of possible infringement of his patent. In the present case, Applicant never abandoned the rights to the invention. Rather, Applicant chose to pursue patenting of the invention in a continuation application, making the petition process obsolete. Thus, while the application may have been allowed to go abandoned in the present case, the invention continued to be prosecuted in a continuation application which Applicant's attorney had every reason to believe had a proper filing date. The holding in Korsinsky v. Godici is clearly inapplicable to the present application.

C. The Decision points out that the statements made in the Petition filed on November 1, 2007 are not supported by a factual showing by the attorneys at the Dickstein Firm, who prosecuted the applications in the 1993-1994 time frame. *See 2nd full paragraph on page 6 of the Decision.*

The Decision is correct in that regard. Accordingly, a Declaration signed by the responsible attorney of record at the time is attached to this Request for Reconsideration. It is believed that the Declaration confirms the prior statements made in the Petition.

D. With regard to the Petition under 37 C.F.R. §1.53(b), the Decision notes that the requirements for a proper Declaration have yet to be satisfied in the present case and as such a filing date cannot be granted. *See 3rd full paragraph on page 6 of the Decision.*

Petitioner believed that since a proper Declaration was filed in the child application and since a filing date is being sought for the above-captioned application simply for continuity purposes, that there would not be a requirement for obtaining a signed Declaration for the same disclosure simply because it has a different serial number assigned thereto. Additionally, given the

many years that have lapsed and that a number of inventors have since become deceased, it was very difficult

to have the same application re-executed. Nevertheless, in an attempt to meet every requirement made in the Dismissal, all inventors or executors of the estate of the deceased inventors have been presented with a Declaration. Since the signatures of all the inventors or executors could not be obtained, the Declaration is being filed under separate cover along with a petition under 37 C.F.R. §1.47.

E. The Decision notes that Petitioner's request to have the Specification amended to include reference to the claimed priority benefits cannot be granted because the present application has not been accorded a filing date. *See 4th full paragraph on page 6 of the Decision.*

Petitioner submits that a proper showing has been made justifying the grant of a filing date to the above-captioned application. Once a filing date is granted, the request to have the Specification amended to reflect proper priority benefits under 35 U.S.C. §120 becomes entirely appropriate.

F. The Decision refuses to reallocate the previously charged fees on the basis that it finds that appropriate authorization to charge the fees has not been given and that proceedings had been terminated since the present application has not been assigned a filing date. Additionally, the Decision holds that the rules at the time required an allocation of all fees paid. *See paragraph bridging page 6 and page 7 of the Decision.*

Again, any concerns with the current status of the present application should become moot once a filing date is assigned to the present application. With regard to the requirement that all fee payments be allocated, it is respectfully submitted that no such requirement existed at the time. The statement in the Decision that "no blanket fee authorization was given" focuses only on the third paragraph of the Petition for Extension of Time filed on February 28, 1994. The second paragraph of the Petition for Extension of Time states "[i]f ... a fee is due...the Commissioner is authorized to charge any fee or additional amounts due in connection with this communication...".

Moreover, continuing on page 7 of the Decision, the PTO mischaracterizes 37 C.F.R. 1.22(b) as requiring fees to be itemized. The rule at that time did not have such mandatory language. The rule actually said that fees paid to the PTO “should” be itemized. The word “should” was not changed to “must” until November 7, 2000. According to the PTO, the change was made in 2000 because it “need[ed] fees to be submitted in such a manner that it is clear for which purpose the fees are paid.” *Changes to Implement the Patent Business Goals, Part II*, 65 F.R. 54604 (September 8, 2008) (copy of relevant portions is enclosed). Even with the new mandatory language, the PTO indicated that the itemization requirement should not be strictly enforced. That is, the PTO said that “[t]he intent of the amendment” (changing “should” to “must”) was “to encourage a better explanation by applicants so that Office employees can properly account for the payments being made by applicants and not to find ways to hold a statement deficient” (emphasis added). *Id.*

Nevertheless, if payment of fees is the sole remaining issue, authorization is given in this Request for Reconsideration whereby the PTO may charge any fees necessary for grant of the requested relief.

G. The Decision questions Applicant’s actions with regard to following proper procedures in this case, rather than what transpired in a child application. The Decision also reiterates the Deciding Official’s impression that Applicant was on notice back during the 1994 time frame as to filing date problems in the sandwich application. *See first full paragraph on page 7 of the Decision.*

As explained above, Applicant was having difficulty with obtaining a proper Declaration signed by all the inventors due to the fact that one of the inventors had been deceased. While filing a continuation application without addressing the dismissal rendered in the sandwich application may not have been entirely correct, Applicant’s attorney was unaware at the time of filing the continuation child application that procedural lapses were present in the sandwich application. No one associated with Applicant was aware of these procedural irregularities until they were raised in October 2007. No harm resulted from these procedural irregularities, as the public was clearly on notice that the child patent was claiming benefits under 35 USC 120 to the sandwich application and

the parent patent. With 20/20 hindsight, the Dismissal points out the procedural steps that Applicant should have taken back in the 1993-1994 time frame. It is important to remember that the very existence of petitions is for the purpose of correcting procedural irregularities. On one hand, the PTO could conclude that the procedural irregularities were inadvertent and harmless to the public. On the other hand, if the PTO were to insist that Applicant should have filed the documents that were filed in the child application in the sandwich application and refuse to grant relief, it would leave a cloud of uncertainty over the issued child patent. That is the very essence of 37 CFR § 1.183, that relief be granted by waiving certain requirements of the rules where justice requires such waiver. It is respectfully submitted that justice requires grant of relief in this case, as the errors were of rather minor procedural consequence (i.e., the Declaration and Petition under 37 C.F.R. §1.47 could have been filed in the sandwich application, rather than the continuation child application, especially if the PTO had alerted Applicant in a timely fashion of problems in the child application claim of priority benefits under 35 U.S.C. §120), particularly as compared to the great harm in leaving a cloud of uncertainty over an issued patent.

The Decision further asserts that Applicant's counsel's failure to exercise due care and lack of knowledge of rules or procedures do not justify waiver of rules. *See 2nd and 3rd full paragraph on page 7 of the Decision.*

It is respectfully submitted that this is not a case where Applicant's counsel was unaware of rules or procedures. Nor is it a case of failure to exercise due care. In fact, Applicant's counsel exercised an abundance of caution and due care by taking steps to file a 2nd sandwich application when the filing of the 1st one was not acknowledged by the Dickstein Firm's courier. Furthermore, trying to perfect a Declaration in a continuation application when difficulties were encountered in the sandwich application due to the fact that one of the inventors had become deceased, does not amount to a lack of knowledge of the rules that would prohibit grant of the requested relief. Lastly, it is worth bearing in mind that, but for the error related to copying all the pages of an application, for filing as a copy in a continuation application, where the PTO already had in its possession a copy of the missing page 1, none of the subsequent events that led to the problems encountered herein would have been a factor.

RELIEF REQUESTED

Petitioner hereby reiterates the relief requested in the Petition filed on November 1, 2007. Specifically:

1. Petitioner requests that this Petition be considered on its merits, in spite of being filed outside the two month period set in the Decision of February 20, 1994 in the above-captioned application (the 2nd sandwich application). That decision referred to 37 C.F.R. §1.181(f) for support of the deadline being set at two months. However, that two month period is not a statutory period for response. As clearly stated in 37 C.F.R. §1.181(f), “[A]ny petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided.” (emphasis added). A Petition for Reconsideration was not filed earlier simply because Applicant was not alerted to the fact that the 2nd sandwich application did not include a claim of priority benefit to the parent application. Furthermore, the PTO contributed to Applicant’s false sense of security by its positive act of granting the petition filed in the child application without alerting Applicant to corrective steps that could have been taken earlier in the 2nd sandwich application. The equity is clearly on the side of Applicant and justice requires that the relief sought herein be granted on the basis of:

(a) examination of the child application proceeded as if a Petition for Reconsideration had been timely filed and granted in the 2nd sandwich application;

(b) the general public could not have relied on a belief that priority benefits were not being claimed because the public was not aware of any errors in the 2nd sandwich application since that application was not publicly available;

(c) the child application provided clear notice to the Examiner as well as to the general public that benefits under 35 U.S.C. §120 were being claimed to the filing date of the parent application via the 2nd sandwich application; and

(d) the interests of the patent owner of the child application could be severely harmed if a cloud of uncertainty were permitted to exist over the effective filing date of the child application which matured into patent 6,546,399. The PTO has recognized the unfairness of the harsh consequences that applicants may suffer when a filing date is not granted under these types of circumstances. While this application was being processed by the PTO based on the practice at the time, the practice was subsequently changed (Petitioner is uncertain of the exact date of change, though it might have been sometime in June 1994) to grant a filing date in situations where a page is missing from the application as filed. Thus, the current version of the MPEP, section 601.01(d) calls for a filing date to be granted to an application filed with a missing page even if applicant fails to respond to a "Notice of Omitted Item(s)" (see MPEP 601.01(d) section I(C)(1)). While the Deciding Official correctly points out that this change in practice was not in effect at the relevant time, it is respectfully submitted that, consistent with PTO practice in other cases, the Deciding Official could consider this factor when deciding whether relief should be granted in this case.

2. Petitioner requests that the PTO apply the extension of time fee tendered on February 28, 2004 to any required filing fee in the above-captioned application (the 2nd sandwich application), or the retention fee necessary to permit priority benefits under 35 U.S.C. §120 for the child application. Since an extension of time for four months was in fact not required at the time of filing the child continuation application on February 28, 1994, subsequent to the dismissal of February 16, 1994, which set a two month period for Response, this excess fee collected could be applied to any retention fees or filing fees required. Additionally, any shortages in the fees paid could have been charged in accordance with the general authorization provided in the February 28, 1994 filing of the request for extension of time. If the PTO is unable to apply the fees already paid or to charge the required fees in this manner, then authorization is hereby given to have any required fees charged to Petitioner's deposit account 50-2929.

3. Petitioner requests by way of a separately filed earlier Amendment that the above-identified Application be amended to reflect the deletion of page 1 and that the priority claim read as follows:

On page 2 before line 1, please insert the following: -- This is a continuation of Application No. 07/426, 917, filed October 26, 1989, now U. S. Pat. No. 5,241,671. --

4. Insofar as the doctrine of laches is concerned, Petitioner is simply asking that this Petition be granted to further clarify the record by establishing a clear line of priority benefits from the child application to the parent application by having a filing date of August 31, 1993 granted to the above-captioned application (the 2nd sandwich application). Once a filing date is granted, the deciding official is authorized to abandon the present application effective February 29, 1994 in favor of the child application which matured into a patent.

CONCLUSION

Grant of the Petition and relief outlined above are respectfully requested.

To the extent that any filing fees, document retention fees or other fees are owed to the Patent Office regarding the above-captioned Application, the Commissioner is authorized to charge such fees to Petitioner's Deposit Account No. 50-2929, making reference to docket number J8300.1.

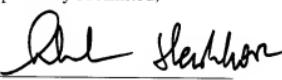
To the extent determined *sua sponte* by the Commissioner or his designee, Petitioner also requests suspension of the rules under 37 C.F.R. §1.183 if necessary, and authorizes payment of any required petition fees thereunder by charging Deposit Account 50-2929.

Petitioner is uncertain as to the charges that the deciding official will deem necessary. Accordingly, no payment is enclosed. Rather, payment of any fees required to grant, on an expedited basis, a filing date of August 31, 1993 to the above-captioned application, and to amend the above-captioned application to include the above-noted claim of priority benefits under 35 U.S.C. §120 are hereby authorized to be charged to Deposit Account 50-2929, making reference to docket number J8300.1.

Dated: October 6, 2008

Respectfully submitted,

By


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